

REMARKS

In the 11 October 2005 Office Action claims 43 – 50, 52 – 62, 64 – 75 and 77 – 79 are rejected under § 102 as being anticipated by U.S. Patent 5,812,988 (hereinafter, Sandretto). The Assignee respectfully traverses the rejections for anticipation by noting that the Office action has failed to establish a prima facie case of anticipation for the rejected claims. More specifically, the Office Action fails to establish a prima facie case of anticipation in as many as three separate ways for every rejected claim.

The first way in which the 11 October 2005 Office Action fails to establish a prima facie case of anticipation for many of the claims is that the Sandretto reference fails to describe every element of the claim. MPEP 2131 notes that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The second way in which the 11 October 2005 Office Action fails to establish a prima facie case of anticipation for many of the claims is that the Sandretto reference fails to provide the same level of detail that is present in the claim. MPEP 2131 notes that anticipation requires that:

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The third way in which the 11 October 2005 Office Action fails to establish a prima facie case of anticipation for many of the claims is that the Office Action does not describe the basis in fact or technical reasoning that is required to support the allegations regarding allegedly inherent characteristics contained in the Sandretto reference. MPEP 2112 notes that:

"In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

The tables below itemizes the presence of up to three failure modes for every claim rejected under § 102. The "inherency not explained" failure mode was included for both claims where inherency was not explained in accordance with the requirements noted in MPEP 2112 and for claims where the Office Action seems to indicate that Sandretto provides

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express support for claim limitations that do not appear to be expressly supported by the Sandretto specification.

	General failures include:	Specific failures include:
43	Missing elements, insufficient detail and inherency not explained	Missing hidden layer, missing network models, lack of detail aggregating data, lack of detail impact and inherency not explained
44	Missing elements and insufficient detail	Missing revenue, expense and capital change
45	Missing elements, insufficient detail and inherency not explained	No value driver summary, no impact on other elements of value, lack of detail
46	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
47	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
48	Missing elements and insufficient detail	No point in time from sequential point in time
49	Missing elements, insufficient detail and inherency not explained	No relative contribution, no net present value, no combination
50	Missing elements, insufficient detail and inherency not explained	No brands, customers, employees, partnerships, vendors, etc.
52	Missing elements and insufficient detail	No growth options and/or market sentiment
53	Missing elements and insufficient detail	No display of growth options, market sentiment, value by element, etc.
54	Missing elements, insufficient detail and inherency not explained	Missing hidden layer, missing network models, lack of detail aggregating data, lack of detail impact and inherency not explained
55	Missing elements, insufficient detail and inherency not explained	Missing revenue, expense and capital change
56	Missing elements, insufficient detail and inherency not explained	No value driver summary, no impact on other elements of value, lack of detail
57	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
58	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
59	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
60	Missing elements and insufficient detail	No point in time, sequential point in time
61	Missing elements and insufficient detail	No relative contribution, no net present value, no combination
62	Missing elements, insufficient detail and inherency not explained	No brands, customers, employees, partnerships, vendors, etc.
64		Discusses analyzing separable assets for a firm, independent claim is missing elements
65	Missing elements and insufficient detail	No growth options and/or market sentiment

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	General failures include:	Specific failures include:
66	Missing elements and insufficient detail	No basic financial system, human resource system, advanced financial system, sales system, operations system, accounts receivable system, accounts payable system, capital asset system, inventory system, invoicing system, payroll system, purchasing system, the Internet
67	Missing elements, insufficient detail and inherency not explained	Missing hidden layer, missing network models, lack of detail aggregating data, lack of detail impact and inherency not explained
68	Missing elements and insufficient detail	Missing revenue, expense and capital change
69	Missing elements and insufficient detail	No value driver summary, no impact on other elements of value, lack of detail
70	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
71	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
72	Missing elements, insufficient detail and inherency not explained	No weights, no revenue, no expense, no capital change
73	Missing elements and insufficient detail	No point in time from sequential point in time
74	Missing elements and insufficient detail	No relative contribution, no net present value, no combination
75	Missing elements, insufficient detail and inherency not explained	No brands, customers, employees, partnerships, vendors, etc.
77		Discusses analyzing separable assets for a firm, independent claim is missing elements
78	Missing elements and insufficient detail	No growth options and/or market sentiment
79	Missing elements, insufficient detail and inherency not explained	No basic financial system, a human resource system, an advanced financial system, a sales system, an operations system, accounts receivable system, accounts payable system, capital asset system, inventory system, invoicing system, payroll system, purchasing system or Internet

Summarizing the above, the 11 October 2005 Office Action has failed to identify the facts required to establish a prima facie case of anticipation for a single claim. The complete failure to identify anticipation at the claim level clearly illustrates the fact that the cited reference is not even remotely similar to the claimed invention. As noted in MPEP 2112, anticipation requires that a substantial identity be established. Taken together, these failures

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provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. The Assignee notes that there are still other ways in which all §102 anticipation rejections in the 11 October 2005 Office Action for claims 43 – 50, 52 – 62, 64 – 75 and 77 – 79 can be traversed.

In the 11 October 2005 Office Action, claims 51, 63 and 76 are rejected under §103 as being unpatentable over Sandretto in view of Jost. The Assignee respectfully traverses the §103 rejections of claims 51, 63 and 76 in two ways. First, by noting that the Office Action does not teach how the cited references could be combined to produce anything useful. Second, by noting that the cited combination of references fails to establish a prima facie case of obviousness. The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 11 October 2005 Office Action for claims 51, 63 and 76 can be traversed.

The first traversal of the § 103 rejections of claims 51, 63 and 76 is based on the fact that the 11 October 2005 Office Action does not teach how neural network models of real estate and a system for simulating returns and risk measures could be combined to produce anything useful. It is well established that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). In spite of this well know requirement, the Office Action has not described how the teachings of these references would be combined or the reason for doing so. The Examiner mentions the desire of Jost to provide more accurate valuations for real estate as being a possible motivation. This argument is not persuasive as the Examiner has not described how the combination would improve the accuracy of valuations for real estate or anything else. Because the Examiner was not able to explain how the references would be combined, it would be (and is) unreasonable to expect the proposed combination to be successful.

As discussed previously, the 11 October 2005 Office Action fails to establish the prima facie case of obviousness required to sustain the rejections of claim 51, 63 and 76. MPEP 2142 provides that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As detailed below, the 11 October 2005 Office Action fails to meet all three of the criteria for establishing a prima facie case of obviousness for claims 51, 63 and 76.

The 11 October 2005 Office Action fails to meet the first criteria for establishing a prima facie cause of obviousness for claims 51, 63 and 76 because the Office Action does not identify any motivation for making the theoretical combination contained in the Office Action. It is well established that "teachings of references can be combined only if there is some suggestion or incentive to do so" quoting ACS Hosp. Sys., Inc. v Montefiore Hosp., 732 F.2d 1572, 1577 221 U.S.PQ 929,933 (Fed. Cir. 1984). This need is particularly acute in cases such as this where the claimed invention is not directly related to the primary field of either reference. The Examiner mentions the desire of Jost to provide more accurate valuations for real estate as being a possible motivation. However, this argument is not persuasive because the Examiner has not described how the combination would improve the accuracy of valuations for real estate or anything else. The Office Action does not describe any possible motivation for making the unlikely combination of an invention designed to evaluate real estate and an invention designed primarily for evaluating portfolios of securities.

The 11 October 2005 Office Action fails to meet the second criteria for establishing a prima facie case of obviousness for claims 51, 63 and 76 because it does not cite a combination of teachings that has a reasonable expectation of success. As noted previously, it would be unreasonable to expect the proposed combination to be successful, when the Examiner who proposed the theoretical combination was unwilling and/or unable to explain how the references would be combined to produce anything useful.

The 11 October 2005 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more of the limitations for every independent claim. The tables shown above list a number of elements that are missing from the independent claims, 43, 54 and 67, that dependent claims 51, 63 and 76 respectively, rely on.

Far from establishing a prima facie case of obviousness for claims 51, 63 and 76, the cited combination of references in the 11 October 2005 Office Action provides additional

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evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of references when there is no motivation to combine them, by citing a combination of references that does not appear to have a reasonable chance for success and by relying on a combination of references that fails to teach or suggest almost all of the claim limitations.

The Assignee notes again that there are still other ways in which all §103 obviousness rejections in the 11 October 2005 Office Action for claims 51, 63 and 76 can be traversed.


Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,


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